

REMARKS

Reconsideration of the October 15, 2004 Office Action is respectfully solicited.

The claims presented herein find support as follows:

Claims 26-31, 33-36 and 39 et seq. are supported by original claims. Claims 32, 37 and 38 find literal basis at page 3 et seq (specification).

The previous Claims and the claims presented herein are believed to be novel and unobvious over the art of record. The U.S. PATENT AND TRADEMARK OFFICE Examiner [hereinafter "U.S. PTO"] has rejected the Claims over Hirooka et al (US 5330813) in view of Marantz et al (US 3989622) and Milaniak et al (US 5366765). Applicants respectfully traverse the grounds of rejection.

Applicants are guided by the Manual of Patent Examining Procedure Section 2100-131 [Rev.2, May 2004] in which two of the three headings state:

"FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS...
THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE"

In applicants' view, none of the three applied references describe or suggest, alone or in combination, use of a liquid, semi-liquid or paste as required by applicants' claims.

In fact, Hirooka et al is directed to a patch comprising a film and a heat-resistant silicone pressure sensitive adhesive, provided on one side of the film. Please see ABSTRACT. As Hirooka et al note, at column 2, line 66 et seq., "It will be possible to

form an anti-carburizing, anti-oxidizing film simply by attaching the film shaped material to a surface of a substrate."

In summary, Hirooka et al. does not describe a liquid, semiliquid or paste-like composition, which is supplied to a metal surface without a patch. Moreover, Hirooka et al. does not describe applying a liquid, semi-liquid or paste-like composition to a surface and drying the composition. Please see Claim 27. In applicants' view, the recitations of liquid, semi-liquid or paste is antithetical to the patch embodiment including a pressure sensitive adhesive, required by Hirooka et al. [Please see Hirooka et al, column 2, lines 35-40.] In applicants' view, the grounds of rejection falls within Section 2100-131 of MPEP, excerpted above.

Neither of the secondary references make up for the Hirooka et al deficiencies. Milaniak et al is directed to an aluminum containing composition which is applied to a metal article; heated at 1350-2250°F for between 4 hours and 24 hours to transfer the aluminum to the surfaces of the passages and diffuse the aluminum into the substrate. Marantz is directed to adsorbing urease in an aqueous environment on a urease retaining material selected from the group comprising aluminum oxide and magnesium silicate and is thereafter insoluble so that when contacted by liquid containing urea, the urea is converted into ammonium carbonate while the urease remains adsorbed on the retaining material.

The secondary references are non-analogous art to Hirooka et al patent. In other words, the secondary references are directed to different fields of endeavor from those of Hiroka et al. While the USPTO combines the references to reject the instant application,

applicants' opinion is that nothing in any one of the three references would suggest such a combination to arrive at applicants' invention.

Moreover, the inventions of the secondary art, if used to modify the Hirooka et al patch, would render the Hirooka et al patch inoperative. These secondary references do not relate to pressure sensitive materials and embodiments described by Hirooka et al.

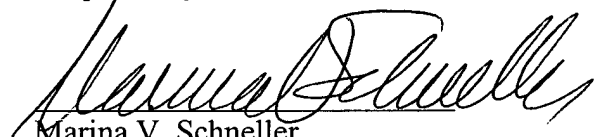
In summary, none of the references alone or in combination describe or suggest the original claims or the claims presented herein.

Reconsideration and an early allowance are respectfully solicited.

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Respectfully submitted,



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